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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/572,865	06/13/2007	Gary Moore	DEP5178USPCT	7275
27777	7590	11/24/2009	EXAMINER	
PHILIP S. JOHNSON JOHNSON & JOHNSON ONE JOHNSON & JOHNSON PLAZA NEW BRUNSWICK, NJ 08933-7003			WAGGLE, JR, LARRY E	
			ART UNIT	PAPER NUMBER
			3775	
			MAIL DATE	DELIVERY MODE
			11/24/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/572,865

Applicant(s)

MOORE ET AL.

Examiner

Larry E. Waggle, Jr

Art Unit

3775

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 August 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 March 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/GS/US)
- _____ Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
- _____ Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Abstract

The abstract of the disclosure is objected to because in line 2, the sentences ending in "sleeve," and beginning in "A frame" are separated by a comma. They should be separated by a period. Correction is required. See MPEP § 608.01(b).

Specification

The amendments to the specification filed 12 August 2009 have not been entered because they are not made with respect to the specification of application 10/572865. They are made with respect to publication 2007/0276400. The application is under examination, not the publication. The objections remain, see Office Action mailed 12 May 2009, pages 3-4.

Claim Objections

Claim 4 is objected to because of the following informality: In line 2, the phrase "between upper clamping" should read "between the upper clamping." Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-4 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification discloses what is meant by an

upper pair of clamping surfaces, provided by the drill guide and the housing, and a lower pair of clamping surfaces, provided by the drill guide bulb and the internal wall of the recess. As best understood by the examiner from the disclosure, the **upper clamping surfaces** include the upper surface of the collar and the lower surface of the washer, the **lower clamping surfaces** include the internal wall of the recess and the surface of the drill guide bulb, the convexity and concavity of surfaces pertains to the **upper clamping surfaces**, and the washer is provided between either the pair of **upper clamping surfaces** or the pair of **lower clamping surfaces** (pages 2-4 of the specification). Therefore, an upper clamping surface and a lower clamping surface can't contact one another (as per amended claim 1), the lower clamping surface is provided either by the recess or the drill guide bulb, not on the collar (as per amended claim 2), one of the lower clamping surfaces is either hemispherical or rounded, not convex (as per amended claim 3), and, the washer can't be disposed between an upper and a lower clamping surface (as per amended claim 4).

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 6 recites the limitation "the actuator" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-3 and 7-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marchione et al. (US Patent 6595999) in view of Ashton et al. (US Publication 2006/0271058).

Marchione et al. disclose a drill guide assembly comprising a drill guide that includes a sleeve (6) and a bulb (7) at one end of the sleeve; a frame fastenable (via 9) to the bone comprising a housing (3) having an internal surface (33) that defines a recess, a platform (top of 2, displacement element in Figure 9) that defines a plane that is spaced apart from the bone and an axis of the assembly (along 14) that extends perpendicular (column 5, lines 13-19) to the plane and three legs (9), and wherein the

drill guide is mounted on the platform so that the drill guide is translatable relative to the frame generally in the plane of the platform, the drill guide and housing being movable relative to one another from a first position (i.e. prior to the tightening of 5), where the angular orientation of the drill guide sleeve relative to the housing can be adjusted by movement of the bulb within the recess, to a second position (i.e. after the tightening of 5), where the bulb of the drill guide contacts the internal surface of the housing; an upper clamping surface (i.e. lower surface of 7) carried on the drill guide; a lower clamping surface (33) carried on the housing; an actuator (5); and an alignment stylus (13) connected to the drill guide to move with the drill guide relative to the frame including a first limb that is directed towards the bone, to facilitate assessment of the alignment of the drill guide sleeve relative to anatomical features of the bone, wherein the stylus can be moved rotatably around the drill guide sleeve, the stylus can be moved around the drill guide sleeve while the clamp is engaged to prevent angular movement of the drill guide relative to the frame, and wherein the stylus includes a second limb extending from the first limb in a direction generally towards the axis of the assembly (Figure 8 and column 5, lines 25-60) (Figures 5-8 and 10 and columns 3-5).

Marchione et al. disclose the claimed invention except for the upper clamping surface being spaced apart from the bulb along the drill guide sleeve, an actuator a lock, and the length of at least one of the first and second limbs of the stylus being adjustable (Figure 1 and page 2, paragraph 0024), wherein the lock and the actuator are actuatable independently of one another. Ashton et al. teach a drill guide assembly (Figure 1) comprising a drill guide (41, 37, 32, 34 and 26); a frame (20, 11, 12 and 13)

comprising an upper concave clamping surface (35) carried of the drill guide (i.e. lower surface of 34) and a lower convex clamping surface (i.e. top surface of 22); an actuator (32); a lock (41), wherein the upper clamping surface is spaced apart from a bulb-like member (26) along a threaded sleeve (29) of the drill guide, the actuator engages with the threaded sleeve, and the lock and the actuator are actuatable independently of one another (i.e. the actuator can be threaded to the sleeve without the lock being threaded to the actuator); and a first limb of a stylus (54) being adjustable (Figure 1 and page 2, paragraph 0024) (Figures 1-2 and paragraphs 0012-26). It would have been obvious to a person having ordinary skill in that art at the time of the invention to construct the invention of Marchione et al. with the drill guide assembly comprising a drill guide; a frame comprising an upper concave clamping surface carried of the drill guide and a lower convex clamping surface; an actuator; and a lock, wherein the upper clamping surface is spaced apart from a bulb-like member along a threaded sleeve of the drill guide, the actuator engages with the threaded sleeve, and the lock and the actuator are actuatable independently of one another and the first limb of the stylus being adjustable in view of Ashton et al. in order to provide structure for accurately securing a drill guide to a femoral head to improve the accuracy of installation of a prosthetic hip resurfacing device.

Marchione et al. disclose the claimed invention except for the ratio of the distance between the point where the bulb and the internal surface of the housing contact one another and the point where the upper clamping surface and lower clamping surface contact one another when the drill guide and the housing are in the

second position to the transverse dimension of the bulb, measured perpendicular to the axis being at least 1.3. It would have been obvious to a person having ordinary skill in that art at the time of the invention to construct the invention of Marchione et al. in view of Ashton et al. with the ratio of the distance between the point where the bulb and the internal surface of the housing contact one another and the point where the upper clamping surface and lower clamping surface contact one another when the drill guide and the housing are in the second position to the transverse dimension of the bulb, measured perpendicular to the axis being at least 1.3 in order to more efficiently secure and lock the drill guide from angular movement, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

Claims 4 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marchione et al. (US Patent 6595999) in view of Ashton et al. (US Publication 2006/0271058) in further view of Reddy (US Patent 3627334).

Marchione et al. in view of Ashton et al. disclose the claimed invention except for a washer being disposed between the upper and lower clamping surfaces. Reddy teaches a deformable washer (10) provided between two surfaces (31 and 32) (Figures 1-3 and column 1, lines 50 - column 2, line 5). It would have been obvious to a person having ordinary skill in that art at the time of the invention to construct the invention of Marchione et al. in view of Ashton et al. with the deformable washer provided between two surfaces in view of Reddy in order to provide a secure connection between the two clamping surfaces to prevent further angular rotation of the drill guide.

Response to Arguments

Applicant's arguments with respect to claims 1-15 have been considered and addressed within the new ground(s) of rejection above.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO0892.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Larry E. Waggle, Jr whose telephone number is 571-270-7110. The examiner can normally be reached on Monday through Thursday, 6:30am to 5pm, EST..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas C. Barrett can be reached on 571-272-4746. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Larry E Waggle, Jr/
Examiner, Art Unit 3775

/Thomas C. Barrett/
Supervisory Patent Examiner, Art
Unit 3775